

REMARKS

This amendment adds new claims 21-35. Applicant previously responded to the rejection of claims 9 and 11 in the substitute amendment filed November 1, 2006, but much of the discussion below may also be responsive to those rejections.

Allowed claims

Allowance of claims 1 and 2 is noted.

New claims 21-37

New claim 21, which is similar to claim 9, is method for inductance testing a board having a planar magnetic circuit and a pair of contacts, including the limitations of registering said planar magnetic circuit with an electrically isolated core, for support see paragraph [0012]; providing a plate complementary to said core, for support see paragraph [0012] and [0045]; contacting said plate with said core, for support see paragraph [0012]; providing a pair of leads, for support see paragraph [0012]; positioning said pair of leads into contact with said pair of contacts using actuation and control, for support see paragraph [0012] and [0030]; delivering an electrical current through said planar magnetic circuit while said plate and said core enhance inductance in said planar magnetic circuit, for support see paragraph [0012]; measuring said inductance in said planar magnetic circuit, for support see paragraph [0012]; and determining whether said inductance is in a predetermined range, for support see paragraph [0012].

In the office action of August 21, 2006, the examiner rejected claim 9 under 35 U.S.C. §101, which requires only that an invention be “new and useful” in order to be patentable. *See* 35 U.S.C. §101. The examiner cited *State St. Bank & Trust Co. v. Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), for the proposition that the claimed invention must produce a “useful, concrete and tangible result,” and rejected claim 9 because the method claimed allegedly “do[es] not produce a real life, real world, useful, concrete, and tangible result.”

Like the method of claim 9, the method of claim 21 is not “the manipulation of an abstract idea,” but rather involves physical components, e.g., a circuit board, a pair of leads, a pair of contacts, a plate, which are registered, positioned and/or contacted so as to measure the inductance of a circuit board, i.e., to determine whether the circuit board is defective.

The determination of whether a circuit board is defective is a real life, real world, useful, concrete and tangible result because, for example, it may reduce or even eliminate the cost and lost productivity which may arise from the processing, use or sale of defective boards. *See* paragraph [0006].

The court in *State St. Bank*, which involved a data processing system for implementing an investment structure, held that the transformation of data by a computer “constitutes a practical application” because “it produces ‘a useful, concrete and tangible result.’” *State St. Bank* at 1373. If the data processing system of *State St. Bank* produces a “useful, concrete and tangible result,” then certainly the method of new claim 21 for testing whether a circuit board is defective produces a “useful, concrete and tangible result.” *Id.*

Accordingly, allowance of new claim 21 is requested.

New claim 22, which depends from new claim 21, includes the further limitation of “approving said board if said inductance is in a predetermined range.” For support see paragraph [0012]. For the reasons stated above with respect to new claim 21 and for the additional limitations, allowance of new claim 22 is requested.

New claim 23, which depends from new claim 22, includes the further limitation wherein “said approved board is further processed, used or sold.” For support see paragraph [0016]. For the reasons stated above with respect to new claim 21 and for the additional limitations, allowance of new claim 23 is requested.

New claim 24, which depends from new claim 21, includes the further limitation of “disapproving said board if said inductance is not in a predetermined range.” For support see paragraph [0016]. For the reasons stated above with respect to new claim 21 and for the additional limitations, allowance of new claim 24 is requested.

New claim 25, which depends from new claim 24, includes the further limitation of “of marking said board if said inductance is not in said predetermined range.” For support see paragraph [0017]. For the reasons stated above with respect to new claim 21 and for the additional limitations, allowance of new claim 25 is requested.

New claim 26, which depends from new claim 25, includes the further limitation “wherein said marking step is accomplished by drilling said board to prevent use of said board and to provide a visible indicator of the non-functional condition of said board.” For support see paragraph [0023]. For the reasons stated above with respect to new claim 21 and for the additional limitations, allowance of new claim 26 is requested.

New claim 27, which depends from new claim 21, includes the further limitation “wherein said actuation is accomplished using at least one motor.” For support see paragraph [0030]. For the reasons stated above with respect to new claim 21 and for the additional limitations, allowance of new claim 27 is requested.

New claim 28, which depends from new claim 21, includes the further limitation “wherein said steps are repeated to test a plurality of boards.” For support see paragraph [0027]. For the reasons stated above with respect to new claim 21 and for the additional limitations, allowance of new claim 28 is requested.

New claim 29 claims a method for inductance testing a plurality of boards. The method incorporates similar steps to that of claim 9, but incorporates a plurality of boards, cores and beds, as well as a carriage. Support for new claim 27 may be found in paragraphs [0008], [0012] and [0027], for example. As discussed above, the method of new claim 28 produces a real life, real world, useful, concrete and tangible result by measuring the inductance of a plurality of circuit boards, i.e., determining whether the circuit boards are defective. Accordingly, allowance of new claim 29 is requested.

New claim 30, which depends from new claim 29, includes the further limitation “approving said boards having an inductance in a predetermined range.” For support see paragraph [0012]. For the reasons stated with respect to new claim 29 and for the additional limitations, allowance of new claim 30 is requested.

New claim 31, which depends from new claim 30, includes the further limitation wherein “said approved boards are further processed, used or sold.” For support see paragraph [0016]. For the reasons stated with respect to new claim 29 and for the additional limitations, allowance of new claim 31 is requested.

New claim 32, which depends from new claim 29, includes the further limitation “disapproving said boards not having an inductance in a predetermined range.” For support see paragraph [0012]. For the reasons stated with respect to new claim 29 and for the additional limitations, allowance of new claim 32 is requested.

New claim 33, which depends from new claim 32, includes the further limitation of “marking said disapproved boards.” For support see paragraph [0017]. For the reasons stated with respect to new claim 29 and for the additional limitations, allowance of new claim 33 is requested.

New claim 34, which depends from new claim 33, includes the further limitation “wherein said marking step is accomplished by drilling said disapproved boards to prevent use of said disapproved boards and to provide a visible indicator of the non-functional condition of said disapproved boards.” For support see paragraph [0023]. For the reasons stated with respect to new claim 29 and for the additional limitations, allowance of new claim 34 is requested.

New claim 35, which depends from new claim 29, includes the further limitation "wherein said actuation is accomplished using at least one motor." For support see paragraph [0030]. For the reasons stated with respect to new claim 29 and for the additional limitations, allowance of new claim 35 is requested.

In sum, for the reasons stated above, allowance of new claims 21-35 is requested.

CONCLUSION

For the foregoing reasons, allowance of new claims 21-35 is requested. If the Examiner believes it would help to advance the prosecution, the undersigned attorney would welcome the opportunity to discuss the application in a telephone interview and can be reached at (312) 201-0011.

Dated this 15th day of December, 2006.

Respectfully submitted,



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